



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

00,18/17 WOHLSTADTER

370208-6220

KM

DAVID EVANS, ESQ.  
ROBERT LEVIN NAFTALIS & FRANKEL LLP  
110 N. 10th AVENUE  
NEW YORK NY 10022

12/18/18

EXAMINER

CHIN, C

ART UNIT

PAPER NUMBER

1841

DATE MAILED:

12/18/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/932,985**

Applicant(s)  
**Wohlstadter et al**

Examiner  
**Chris Chin**

Group Art Unit  
**1641**



☒ Responsive to communication(s) filed on Jun 3, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 5-12, 33-36, and 46-68 is/are pending in the application.

Of the above, claim(s) 33-36 and 63-68 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 5-12 and 46-62 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 5-12, 33-36, and 46-68 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1641

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group I - claims 5-12 and new claims 46-62 in Paper No. 7 is acknowledged. The traversal (concerning claims 33-36 and new claims 63-68) is on the ground(s) that claim 33 does not require an electrode and thus should be included with claims 5-12. This is not found persuasive because the device of claim 33 requires a diaphragm which is not recited in claims 5-12 or claims 46-62 and thus constitutes a separate and patentable device.

Claims 33-36 and 63-68 are non-elected claims.

Claims 5-12 and 46-62 will be examined.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 U.S.C. § 112***

2. Claims 5-12 and 46-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 9 are vague. The preamble of the claims recite an apparatus for carrying out a binding assay but the body of the claims fail to recite any binding reagents for carrying out the binding assay.

Art Unit: 1641

Claims 53 and 62 are vague as it is not clear as to what constitutes an “electromagnetic actuator”. An “electromagnetic actuator” can be anything from an electric motor to a magnetic stirrer.

***Claim Rejections - 35 U.S.C. § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5, 6, 9, 10, 12, 52, and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Grant et al.

Grant et al (U.S. Patent 5,247,954) discloses a megasonic cleaning system for use in cleaning electronic or semiconductor wafers or substrates in a wafer carrier. The system comprises a tank (12) (i.e. a cell) and a plurality of staggered piezoelectric ceramic transducers (16a-16c) and (18a-18c) (i.e. means for sonicating) bonded to an lower surface of tank (12). The piezoelectric ceramic transducers operate in the area of 1.5 megahertz and 0.75 megahertz (cols. 2-3).

Art Unit: 1641

The system of Grant et al is not disclosed as being used for carrying out a binding assay but the intended use recited in the preamble of the rejected claims is not given any patentable weight.

5. Claims 5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Walter.

Walter (U.S. Patent 4,114,194) discloses an ultrasonic cleaner comprising a tank portion (13) (i.e. a cell) wherein an ultrasonic transducer (50) (i.e. a means for sonicating) is attached to a bottom portion of tank portion (13). Ultrasonic transducer (50) is a piezoelectric crystal (cols. 2-4).

The device of Walter is not disclosed as being used for carrying out a binding assay but the intended use recited in the preamble of the rejected claims is not given any patentable weight.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Chin whose telephone number is (703) 308-3991. The examiner can normally be reached on Monday-Thursday from 9:30 am to 7:00 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.


Application/Control Number: 08/932,985

Page 5

Art Unit: 1641

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

cchin/cc  
December 15, 2000

  
CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP ~~1800~~ 1641